### UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS MARSHALL DIVISION

NETLIST, INC.,	
Plaintiff,	) )
vs.	Case No. 2:21-CV-463-JRG
SAMSUNG ELECTRONICS CO., LTD.,	JURY TRIAL DEMANDED
SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR,	Filed Under Seal
INC.,	)
Defendants.	

NETLIST INC.'S MOTION TO STRIKE PORTIONS OF THE OPENING EXPERT REPORT OF JOSEPH MCALEXANDER

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Plaintiff Netlist respectfully requests the Court strike portions of the opening expert report of Joseph McAlexander.

### I. Improper Claim Construction Opinions

Arguing claim construction to the jury is improper. Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d 1356, 1364 n.6 (Fed. Cir. 2008) ("[A]llowing a witness to testify before the jury on claim construction would be improper."); Cordis Corp. v. Boston Sci. Corp., 561 F.3d 1319, 1337 (Fed. Cir. 2009) ("[R]isk of confusing the jury is high when experts opine on claim construction." (quoting CytoLogix Corp. v. Ventana Med. Sys., Inc., 424 F.3d 1168, 1172-73 (Fed. Cir. 2005)); ZiiLabs Inc. v. Samsung Elecs. Co., 2015 WL 8274055, at \*2 (E.D. Tex. Dec. 8, 2015) ("A party has made an improper claim construction argument to the jury when it elicits testimony that goes to the scope of a claim.").

Mr. McAlexand	er offers a series of opi	inions purportedl	y alleging	
		For	, Mr. McAl	exander suggests
				Не
proceeds to				
	This improper cla	im constructions	and all arguments	based on these
proposed constructions	should be stricken.			
Paragraphs	Mr. McAlexander opin	nes that		
	He then conc	ludes that		

Samsung stated during claim construction that
Samsung cannot now raise this
waived claim construction argument through expert testimony. Music Choice v. Stingray Digit. Grp., Inc.,
No. 2:16-cv-586, 2019 WL 8110069, at *3 (E.D. Tex. Nov. 19, 2019) ("[F]ailure to timely raise
claim construction arguments should ordinarily result in waiver of the arguments." (quoting Ericcson
Inc. v. TCL Comme'n Tech. Holdings, Ltd., 2017 WL 5137401, at *15 (E.D. Tex. Nov. 4, 2017)); Maxell,
Ltd. v. Apple Inc., 2020 U.S. Dist. LEXIS 248960, at *71-72 (E.D. Tex. Dec. 17, 2020) ("It is not
appropriate for a defendant to withhold claim construction disputes until rebuttal expert reports when
the disputes are clearly raised by the plaintiff's infringement contentions.").
Further, Mr. McAlexander's claim construction is based on legally improper reasoning.
For example, Mr. McAlexander improperly relies on
This argument is improper to present to a jury, and is entirely
irrelevant to the written description inquiry. ZiiLabs, 2015 WL 8274055, at *2 ("[Experts] cannot rely
on statements in the prosecution history to limit the ordinary meaning of the term. That is for the
Court.").
As another example, Mr. McAlexander improperly
Inventor testimony is not a reliable basis to determine the scope of the claims. See, e.g., Howmedica
Osteonics Corp. v. Wright Med. Tech., Inc., 540 F.3d 1337, 1347 (Fed.Cir. 2008) ("[I]nventor testimony as
to the inventor's subjective intent is irrelevant to the issue of claim construction."); Unwired Planet

L.L.C. v. Google, Inc., 660 F. App'x 974, 984 (Fed. Cir. 2016) ("[I]nevntor testimony as to the inventor's

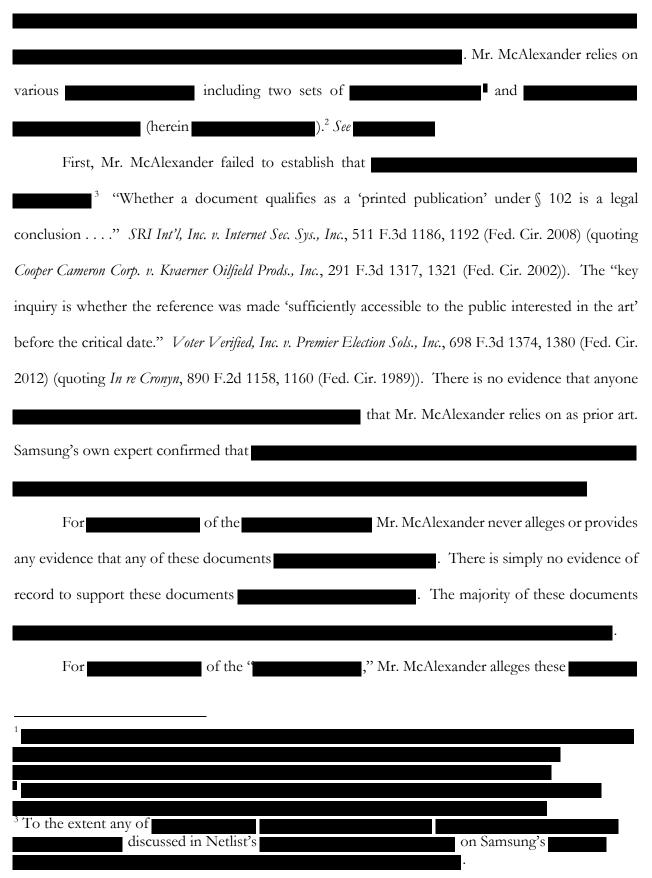
subjective intent is . . . irrelevant as a matter of law[.]"); Navico, Inc. v. Garmin International, Inc. et al, 2-

16-cv-00190 document 363 (EDTX, Aug. 24, 2017) (J. Payne) (granting motion to exclude "testimony by the inventors about the meaning of claim terms"). In addition, Mr. McAlexander suggests that Mr. McAlexander cites no language therefore it is improper to read in this limitation based on See, e.g., EPOS Techs. Ltd. v. Pegasus Techs. Ltd., 766 F.3d 1338, 1341 (Fed. Cir. 2014) ("It is improper to read limitations from a preferred embodiment described in the specification even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited."). this would be an issue for the Court. Finally, Mr. McAlexander's proposed construction is incorrect, and therefore irrelevant. Paragraphs Mr. McAlexander alleges that If this construction is not accepted, he contends If the term is Samsung expressly stated that

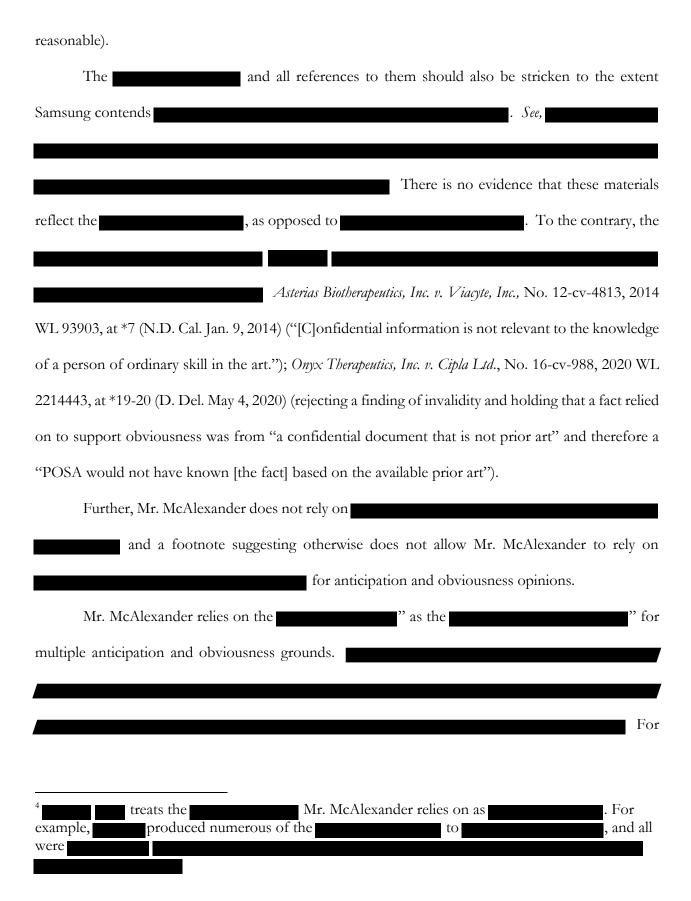
	Samsung cannot now raise this waived claim
construction argument through expert testi	imony. Music Choice, 2019 WL 8110072, at *3; Maxell, 2020
U.S. Dist. LEXIS 248960, at *71-72.	
Paragraphs . Mr. McAlexander	r alleges that
If this construction is no	ot accepted, he contends .
Id. ¶ 210. The Court already rejected Samsu	ung's substantively identical proposed construction
Court that	Samsung argued to the
	and that
	The Court disagreed with
Samsung for multiple reasons.	Mr. McAlexander
relies on already co	ited by Samsung during claim construction and considered
by the Court. <i>Id</i> .	
Paragraph Mr. McAlexander recites	and then cherry-
picks statements from	, including statements that
The construction	n stands for itself, and quoting statements from
or alluding to	is irrelevant and would only serve to confuse the
jury.	
Paragraphs . Mr. M	cAlexander argues that

ICalia apparation in
If this construction is
not accepted, he contends
argument is improper for the jury, has already been waived by Samsung, and should be excluded.
Music Choice, 2019 WL 8110072 at *3; Maxell, 5-19-cv-00036 at 49-50. In support of this proposed
construction, Mr. McAlexander cites
construction, in the mexander cites
He also cites to
This
evidence is irrelevant to written description, would only confuse the jury, and should be excluded.
Paragraphs . Mr. McAlexander argues that
Mr. McAlexander justifies his arguments by citing
This claim construction argument should be excluded. <i>Music Choice</i> , 2019 WL 8110072 at *3:
Paragraphs . Mr. McAlexander argues that
Mr. McAlexander justifies his arguments by citing
This claim construction argument should be
excluded. Music Choice, 2019 WL 8110072 at *3.
. This claim construction
argument suffers from the same issues described above, and should be excluded. Music Choice, 2019

WL 8110072 at *3. Further, Mr. McAlexander's position was already argued by Samsung
and rejected by the Court.
II. Equitable Defenses Including Inequitable Conduct, Unclean Hands, Standards-Based Estoppel, and/or Prosecution Laches
Paragraphs . Inequitable conduct, unclean hands
"standards-based estoppel," and prosecution laches are equitable defense to a charge of patent
infringement that are tried to the Court. Opinions related to these issues have no place before the
jury. See, e.g., Order at 7, Input/Output, Inc. et al v. Sercel, Inc., No. 5-06-cv-00236 (E.D. Tex., Jan. 06
2010) (Dkt. 343) ("The question of laches is committed to the sound discretion of the trial court" and
"evidence related to laches does not sufficiently overlap with other issues as to be properly before the
jury" (citing Hemstreet v. Comput. Entry Sys. Corp., 972 F. 2d 1290, 1292 (Fed. Cir. 1992)).
III. Irrelevant and Prejudicial Arguments About Netlist's
Paragraphs . Mr. McAlexander recites various
Mr. McAlexander makes allegations about
None of this has any relevance to validity and
these unfounded assertions about why Netlist's actions are highly prejudicial. See, e.g., Life Techs., Inc.
v. Clontech Lab'ys, Inc., 224 F.3d 1320, 1325 (Fed. Cir. 2000) (noting that "the path that leads an inventor
to the invention is expressly made irrelevant to patentability by statute" and "[i]t does not matter
whether the inventors reached their invention after an exhaustive study of the prior art").
IV. Failure to Establish that Alleged Printed Publications Constitute Prior Art
Mr. McAlexander relies on numerous documents without establishing that they constitute
prior art. His analysis is improper and the exhibits (and any reliance on them) should be excluded



He cites no evidence to support his assertion, which closely tracks
the language used by Samsung's attorneys in
Even if this unsupported assertion were accepted as
true, it alone is insufficient to establish
Samsung Elecs. Co. v. Infobridge Pte. Ltd., 929 F.3d 1363, 1372 (Fed. Cir. 2019) (to determine whether a
document is publicly accessible, the analysis should focus on the knowledge of those "outside the
authoring organization," because "[t]o hold otherwise would disincentivize collaboration and depart
from what it means to <i>publish</i> something." (emphasis added)); C.R. Bard, Inc. v. AngioDynamics, Inc.,
748 F. App'x 1009, 1014-15 (Fed. Cir. 2018) (holding a product guide that "bears some indicia of a
public-facing document" was not publicly available, noting that "even if a member of the relevant
public could have requested it, there is [no] evidence that they would have had a reason to do so");
Koninklijke Philips N.V. v. Zoll Med. Corp., 656 F. App'x 504, 529 (Fed. Cir. 2016) (rejecting assertions
"that some member of the public could have found out about the application, requested it from the
FDA, and then received it, because the confidentiality of the application had expired" as "rel[ying] on
a considerable amount of conjecture that is not supported by the record," including that there was
"no evidence of indexing or cataloguing, which, while not prerequisites, serve as hallmarks of public
accessibility"); Cordis, 561 F.3d at 1335 (affirming district court's summary judgment order finding the
inventors' monographs were not prior art even though they were disclosed to the inventor's colleagues
and two commercial entities without an explicitly legal obligation of confidentiality because the
defendant could not provide evidence showing the inventor's expectation of confidentiality was not

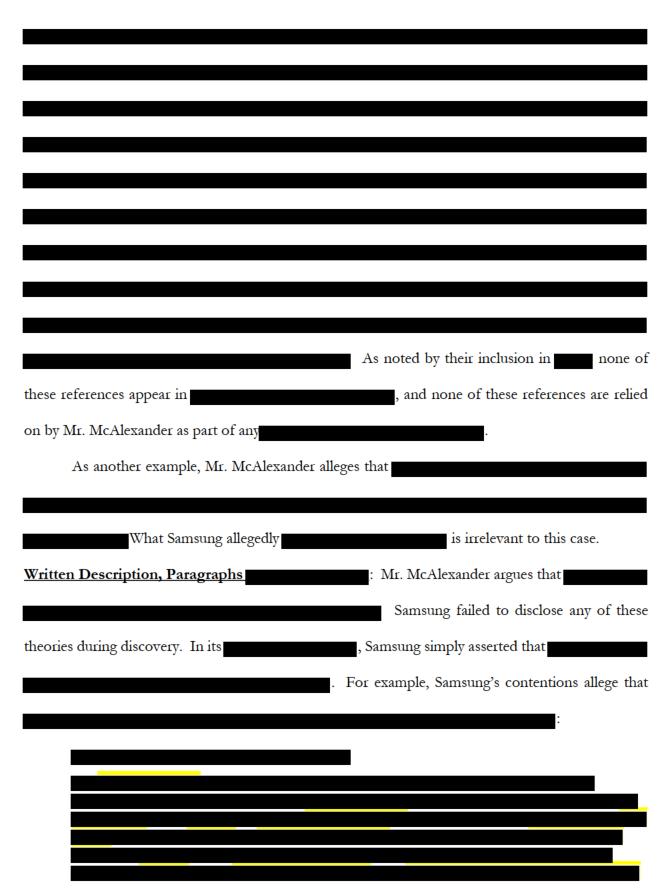


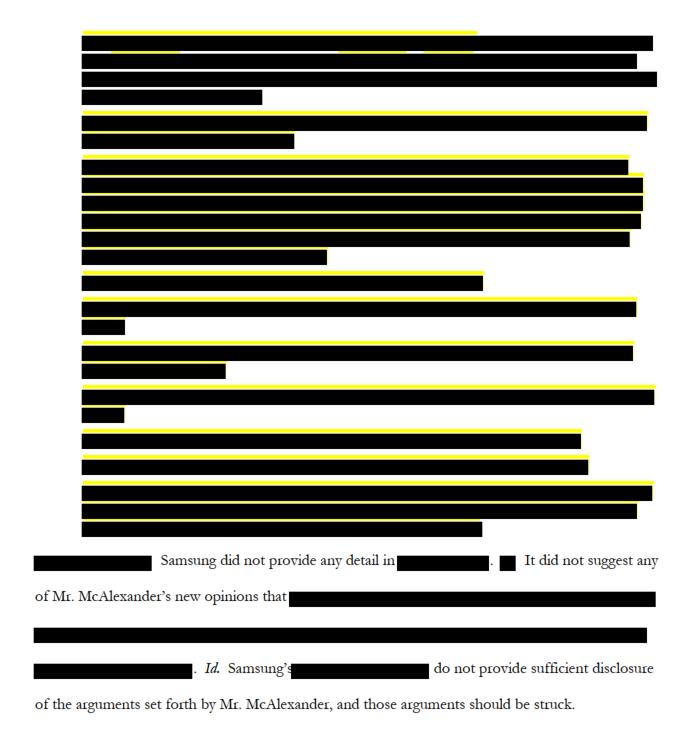
every claim ele	ment under these grounds Mr. McAlexander opir	nes that
Mr. McA	Alexander starts his analysis for each limitation b	by citing to
does not discl	ose	Не
	It is clear Mr. McAlexando	er knew
does not	which he does for each of the other crown	Similarly, Mr. McAlexander
Mr. Mo	, which he does for each of the other ground cAlexander alleges that the	us asserted against
with the	, none of the grounds involving the  Of the seven	refer to  Mr. McAlexander
	For the Mr. McAlexan	der
		(citing
	as evidence	

	(citing	as evidence	
IL and coto	d aitationa to		
. His repeate	ed citations to		
Nigra of the series to the series			
None of these instances		·	
Second, Mr. McAlexander trea	ts		
with out optablishing		D	2.0
without establishing		Γ	or
s, he in	cludes		
If this were sufficient,			
·			
For			
	Mr McAlox	andar is antiroly silant	
	MI. MCAlex	ander is entirely silent.	
<u>Paragraphs</u>		Mr. McAlexano	der asserts
			II. roling o
			. He relies on
various documents allegedly relating to	without esta	ablishing that	i
5			

He offers no opinions anywhere in his report to suggest any of these documents were
In relation to a 102(f) defense, Mr. McAlexander makes certain
allegations about , but says nothing about the specific
references he relies on. Further, as discussed above in relation to the
that
; Samsung Elecs.
Co., 929 F.3d at 1372 (Fed. Cir. 2019). Similarly, the "" that he alleges
does not list any of the documents he relies on as prior art.
also offers no opinions supporting a motivation to combine
V. Improper Arguments Regarding Written Description
Paragraphs . Mr. McAlexander alleges that the c
As discussed above in § I.A, this is nothing more than a surreptitious attempt at
, arguing that . Because the claims
allegedly do not include these structures, Mr. McAlexander argues that
This is not a legally relevant basis for written description: 35
U.S.C. § 112 ¶ 1 does not require that a claim recite every aspect of the solution described in a patent,
or all of the solutions posed to resolve different problems in the art. Crown Packaging Tech., Inc. v. Ball
Metal Beverage Container Corp., 635 F.3d 1373, 1382 (Fed. Cir. 2011) (reversing district court finding of
invalidity for lack of written description support, and noting that "[t]he problems the patents address
are related, but they are still separate, and solving one does not necessarily require solving the other").
Further, Mr. McAlexander discusses asserts that
is irrelevant to written

description. And a discussion of how individual claim elements are
without the other elements of an obviousness analysis, would cause juror confusion and be highly
prejudicial to Netlist. In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006) ("[M]ere identification in the prior
art of each element is insufficient to defeat the patentability of the combined subject matter as a
whole.").
VI. Irrelevant Other Litigation
McAlexander Paragraphs  Mr. McAlexander
presents
These other litigations are not relevant to any
issue in this case. Discussion of other litigation—including that
s—would cause an unnecessary side show, would have a high
probability of juror confusion, and could cause a misleading negative impression of Netlist and the
patents-in-suit.
VII. Invalidity Arguments Not Disclosed by Samsung During Discovery
McAlexander  Mr. McAlexander cites to
These references include
Each of these references should be excluded.
Further, Mr. McAlexander provides
For example, many of the references Mr. McAlexander discusses involve
Tor example, many or the references into incrnexancer discusses involve





Dated: February 3, 2023 Respectfully submitted,

#### /s/ Draft

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Attorneys for Plaintiff Netlist, Inc.

**CERTIFICATE OF SERVICE** 

I hereby certify that, on February 3, 2023, a copy of the foregoing was served to all counsel of

record.

<u>/s/ Yanan Zhao</u> Yanan Zhao

CERTIFICATE OF AUTHORIZATION TO FILE UNDER SEAL

I hereby certify that the foregoing document and exhibits attached hereto are authorized to be

filed under seal pursuant to the Protective Order entered in this Case.

<u>/s/ Yanan Zhao</u>

Yanan Zhao

**CERTIFICATE OF CONFERENCE** 

I hereby certify that, on February 2, 2023 counsel for the parties met and conferred on the

issues raised in this motion. Counsel for Samsung confirmed that Samsung did not intend to withdraw

any of its expert reports, or any portions of its expert reports, and that Samsung would oppose any

motions to strike related to those reports.

/s/ Yanan Zhao

Yanan Zhao

Netlist's Motion To Strike Portions Of The Opening Expert Report Of Joseph McAlexander No 21-cv-463-JRG (E D Tex )

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